

JUL 11 2006

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Date:

July 11, 2006

To:

Examiner: Wai Yip Lam
Art Unit: 2614

Location:

United States Patent and Trademark Office

Fax No.:

571-273-8300

From:

Attorney: Lawrence T. Cullen

Reg. No. 44,489

Subject:

Serial No. 09/927,841 Filed: 8/10/2001 Docket No. D2553

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MESSAGE:

Enclosed herewith, please find Pre-Appeal Brief Request for Review, Notice of Appeal, and fees due for filing in the above-identified application.

CERTIFICATION OF FACSMILILE

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On: 7/11/06 by Lawrence T. Cullen

Attorney Docket No.: D2553

JUL 11 2006

PATENT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Inventor: Kevin T. Chang et al.

Confirmation No.: 7061

U.S. Serial No.: 09/927,841

Customer No.: 000043471

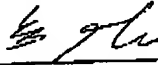
Filed: August 10, 2001

Art Unit: 2614

Examiner: Wai Yip Lam

Title: BTI RF MODULE WITH FILTERING

PRE-APPEAL BRIEF
REQUEST FOR REVIEWMail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF FACSIMILE
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8300
on 7/11/06 by 
Lawrence T. Cullen

Sir,

Please enter these arguments in response to the Final Office Action mailed on January 11,
2006 and conduct a pre-appeal brief conference.

REMARKS

I. Introduction

Claims 1-6 have been canceled without prejudice or disclaimer in Applicant's response
filed March 9, 2006, which is believed to have been entered.¹

Claims 7-19 are pending in the above application.

Claims 7-19 stand rejected under 35 U.S.C. § 103.

Claims 7 and 13 are independent claims.

¹ Applicant's have not received a response to Applicant's After Final Response submitted on March 9, 2006.

II. Prior Art Rejections

A. Claims 7-8, 10 and 13-17 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Williams (U.S. Pat. 5,815,794) in view of Martin (U.S. Pat. 5,020,129).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Neither Williams nor Martin, taken alone or in combination, disclose or suggest each and every limitation of independent claims 7 or 13. Williams does not disclose to selectively provide unimpeded, partially impeded, and full cut off of cable service in the upstream or downstream and upstream paths, as recited by claims 7 and 13, respectively. The Office action appears to recognize these deficiencies of Williams. Office action, pg. 3. Williams only uses duplex filter 370 (Fig. 3) to separate the upstream communication signal from the downstream signal, i.e. Williams does not provide any filtering to the separated upstream communication signal. Martin merely teaches a downstream filtering technique to selectively provide premium content channels to a user. Martin, Abs.; Fig. 1; col. 5: 19-42. Martin also is not concerned with filtering an upstream communication signal.

Apparently recognizing that Martin does not disclose filtering or switching an upstream communication signal, the Office action alleges that "the switching mechanism simply controls which channels should be allowed or denied, without regards to the direction of traffic[. Therefore, the switching mechanism of Martin et al. can be inserted into the upstream path for controlling traffic in the upstream direction." Office action, pg. 6. However, the "switching mechanism" in Martin merely allows a subscriber to access premium content channels in the downstream communication. Martin is not concerned with any upstream communications at all.

Accordingly, the combination of Martin with Williams, even if assumed to be proper, *arguendo*, does not disclose all of the limitations of claims 7 and 13. Hence, the combination of Williams and Martin does not render claims 7 and 13, nor claims 8 and 10, which depend on claim 7, and claims 12-17, which depend on claim 13 unpatentable.

Furthermore, the Examiner is respectfully reminded that the motivation must come from the references themselves. See, MPEP 2143.01, first heading. Moreover, the fact that it is possible to do a modification is not motivation. See, MPEP 2143.01, third heading. In short, the motivation for the combination is illusory. More particularly, while the implementation of Williams occurs in a node which provides service to a plurality of households, the implementation of Martin is primarily intended to be performed at a single subscriber location. There appears to be no suggestion in Martin to operate in a node. Indeed, the use of system of Martin in a node would improperly modify Martin away from its intended purpose by making the premium channels available to all users of the node, rather to individual users as intended by Martin.

Accordingly, the combination of Williams and Martin, as applied against claims 7 and 13 appears to be based on illusory motivation and is improper. Likewise, claims 8 and 10, which

depend on claim 7, and claims 12-17, which depend on claim 13 are not rendered unpatentable by the combination.

B. Claims 9, 12, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Williams in view of Martin and in view of Jung (U.S. Pat. 6,678,893).

Neither Williams, Martin nor Jung taken alone or in combination, disclose or suggest to selectively provide unimpeded, partially impeded, and full cut off of cable service in the upstream or downstream and upstream paths, as recited by amended claims 7 and 13, respectively. Neither Williams nor Martin disclose such as discussed above. Jung also does not disclose such, and the Office action does not appear to rely on Jung as disclosing such. Moreover, Jung does not cure the deficiencies in the combination of Williams and Martin.

Accordingly, as neither Williams, Martin nor Jung taken alone or in combination, disclose or suggest all of the elements of claims 7 or 13, claim 12 which depends on amended claim 7, and claims 18 and 19 which depend on amended claim 13 are not rendered unpatentable by the combination of Williams, Martin and Jung.

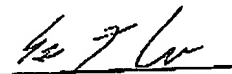
III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Date: 7/11/06

Respectfully submitted,

By: 
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